

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-6 are presently pending before the Office. No claims have been canceled. Applicants have amended the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicants are not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed June 4, 2003 (Paper No. 8) and the references cited therein have been carefully studied by Applicants and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

Relying on 35 U.S.C. §112, second paragraph, the Office has rejected the subject matter of claims 1 - 6 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, more specifically for the reasons stated on page 5 of the Office Action.. Applicants respectfully traverse the rejection and request reconsideration.

Applicants submits that claims 1-6 do define the legal metes and bounds of the invention. It is not the role of the claims to enable one skilled in the art to reproduce the invention but rather to define, for those skilled in the art the legal metes and bounds of the invention. Nevertheless, in

order to advance the case to allowance, claims 1, 2 3 and 5 have been amended to clarify the the claim limitations.

It is respectfully submitted that claims 1-6 fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

Relying on 35 U.S.C. §102(e), the Examiner has rejected the subject matter of claims 1-6 as being anticipated by Chen. Applicants respectfully traverse the rejection and request reconsideration.

The Examiner states that "Chen discloses a binder... for the present claims 4 and 6" as stated on page 3, lines 3-14 in Office Action.

The process described in the present claims 4 and 6 is for the step of eliminating and/or decomposing only a specified amount of the group protecting the phenolic hydroxy group with an acid reagent.

The process disclosed by Chen is for the step of polymerizing acetoxystyrene and ester compounds.

The process described in the present claims 4 and 6 is therefore different from the process disclosed by Chen.

The Examiner also states that "A phenolic polymer (II) can be partially or wholly protected, abstract and column 7 lines 1-15.....for present claims 1, 3, and 5." as stated on page 3, lines 14- to the end of the page and on page 4, line 1 in the Office Action.

The polymer in Example 1 of Chen lacks narrow molecular weight distributions,

because this process was a radical process. The phenolic polymer with narrow molecular weight distributions are prepared by living anionic polymerization or living radical polymerization. But, when using p-t-butoxystyrene in living radical polymerization, the reaction does not proceed. Using p-acetoxystyrene in living radical polymerization, the reaction proceeds, but, the hydrolysis process and functional process of hydroxyl group are needed, so this process is not effective. The polymer by living radical process is not exemplified. When using p-t-butoxystyrene in living anion process, the reaction proceeds, and the aimed polymer can be prepared only by deprotection of a hydroxyl protecting group.

Until Applicants' invention, it was difficult to prepare the aimed polymer because t-butyl group in ester was hydrolyzed at the same time. Applicants were the first, wherein the polymer comprises a phenolic repeating unit partially protected by acid-labile group and acid-labile ester repeating unit without carboxylic acid moiety.

The Examiner also states that "Chen discloses a homogeneous blendfor the present claim 1." as stated on page 4, lines 2-3 in Office Action.

Applicants submit that the homogeneous blend is not relative to the non-existence of free carboxylic acid groups. The hydroxystyrene is polar, so even if there is a carboxylic acid group, the blend becomes homogeneous.

Relying on 35 U.S.C. §102(e), the Examiner has rejected the subject matter of claims 1-2 as being anticipated by JP 10-168132. Applicants respectfully traverse the rejection and request reconsideration.

The cited reference discloses an alkenyl-based copolymer having a narrow distribution, but this polymer is different from Applicants' polymer. In the present invention, phenolic moiety is protected partially by acid-labile groups such as t-butyl, but in the reference, phenolic moiety is not protected, so all hydroxyl group is naked.

Applicants respectfully submit that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

For the above reasons, the cited references fail this test. Accordingly, each and every element of Applicants' claims have not been taught in that single reference. Accordingly, Applicants respectfully submit that claims 1-6 have not been anticipated by the cited references under 35 U.S.C. §102, and respectfully request that such rejection be withdrawn.

CONCLUSION

Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicants respectfully submit that claims 1-6 are patentable over the art of record.

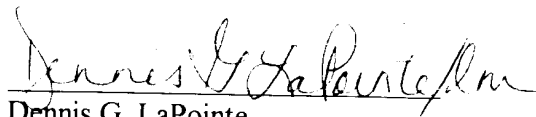
A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an

Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

Dated: 9/3/2003

A handwritten signature in cursive script, appearing to read "Dennis G. LaPointe".

Dennis G. LaPointe

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